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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,235	03/26/2001	Morihiko Sumino	P101201-00017	8723

7590 11/17/2004

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EXAMINER

FERGUSON, KEITH

ART UNIT PAPER NUMBER

2683

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,235

Applicant(s)

SUMINO, MORIHIKO

Examiner

Keith T. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 7 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii in view of Shanoto et al., newly recited reference.

Regarding claim 1, Ishii discloses a portable telephone apparatus (fig. 1) for roaming between a first portable telephone system (fig. 1 number A1) and a second portable telephone system (fig. 1 B1), comprising: reception means (mobile station responds to base station) for receiving a message transmitted from a base station in one of the two systems (col. 4 lines 50-55); judging means for judging whether a received message has a common format in the two systems (col. 4 lines 50-59 and col. 5 lines 40-54) or a different format (i.e. a message including a service option request order for deciding a communication mode) in the two systems (col. 5 lines 31-59); first processing means (the mobile

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telephone responds to the base station) (col. 4 lines 50-55) for processing the received message by performing a procedure common (i.e. the mobile station compares the first mobile radio system flag with existing mobile radio system flag to see if they coincide) (col. 4 line 55 through col. 5 line 6 and col. 5 lines 49-54) to the two systems (fig. 1 system A1 and system B1) when the message has the common format (same protocol software format) (col. 4 lines 60-67). Ishii differs from claim 1 of the present invention in that it does not disclose a second processing means for processing the received message by performing procedures, each procedure unique to each of the two systems, when the message has the different format. Shamoto et al. teaches a PDC/PHS phone (fig. 2) comprising a first processing means (PDC Base band processor) (fig. 2 number 5 and col. 3 lines 18-58) and a second processing means (PHS base band processor) (fig. 2 number 8 and col. 3 lines 18-58), the second processing means for processing the received message by performing procedures (i.e. the PDC/PHS phone processes the reception signal) (col. 3 lines 49-58), each procedure unique to each of the two systems (i.e. the PDC/PHS phone process the reception signal received either through the PDC communication network (fig. 1 number 20) or the PHS communication network (fig. 1 number 22 and col. 3 lines 49-58), when the message has

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the different format (different protocol, i.e. a PDC system communication protocol) (col. 3 lines 50-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ishii portable telephone with second processing means for processing the received message by performing procedures, each procedure unique to each of the two systems, when the message has the different format in order for the portable phone to be able to quickly communicate with the second base station within the second system when roaming without having to download the second system protocol to communicate, as taught by Shamoto et al..

Regarding claim 2, Ishii discloses a protocol revision receiving means (i.e. the mobile telephone receives a revision protocol from area its located) for receiving from the base station (col. 7 line 64 through col. 8 line 26), a protocol revision message showing a type of communication protocol (Pcmda) used in one of the two systems (col. 7 line 64 through col. 8 line 26); wherein the reception means receives a succeeding message (pcdma) which succeeds the protocol revision message (Ptdma) (fig. 3 and col. 7 line 64 through col. 8 line 26), from the base station (fig. 3 and col. 7 line 64 through col. 8 line 26); the second processing means (downloading) processes the

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succeeding message (pcdma) by performing a procedure unique to the first system when the communication protocol in the first system is shown in the protocol revision message (col. 8 lines 6-50), and processes the following message by performing a procedure unique to the second system when the communication protocol in the second system is shown in the protocol revision message (col. 8 lines 6-50).

Regarding claim 3, Ishii discloses a base station (TDMA base station) (fig. 3 number 11) in the first system (fig. 3 number C1) transmits the protocol revision message (TDMA) on a first frequency (Ptdma) (col. 7 lines 5-12), and a base station (CDMA base station) (fig. 3 number 12) in the second system (fig. 3 number D1) transmits the protocol revision message on a second frequency (Pcdma) (fig. 3) (col. 8 lines 6-15), wherein the protocol receiving means (mobile telephone receiver) receives either of the two protocol revision messages by scanning the first frequency (TDMA frequency) and the second frequency (CDMA frequency) (col. 7 lines 54-63).

Regarding claim 4, Ishii discloses a portable telephone apparatus as discussed supra in claim 1 above. Ishii differs from claim 4 of the present invention in that it does not

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disclose the first system is an IS-95 Code Division Multiple Access (CDMA) mobile telephone system, the second system is an ARIB STD-T53 CDMA mobile telephone system. However, IS-95 Code Division Multiple Access (CDMA) mobile telephone systems, and ARIB STD-T53 CDMA mobile telephone systems are well known in the art in cellular or wireless communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the first system to be an IS-95 Code Division Multiple Access (CDMA) mobile telephone system, the second system to be an ARIB STD-T53 CDMA mobile telephone system, since it was known in the art that IS-95 Code Division Multiple Access (CDMA) mobile telephone systems, and ARIB STD-T53 CDMA mobile telephone systems are used in cellular or wireless communication systems.

Regarding claim 5, Ishii discloses a protocol revision receiving means (i.e. the mobile telephone receives a revision protocol from area its located) for receiving from the base station (col. 7 line 64 through col. 8 line 26), a protocol revision message showing a type of communication protocol (Pcmda) used in one of the two systems (col. 7 line 64 through col. 8 line 26); wherein the reception means receives a succeeding message (pcdma) which succeeds the protocol revision message

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(Ptdma) (fig. 3 and col. 7 line 64 through col. 8 line 26), from the base station (fig. 3 and col. 7 line 64 through col. 8 line 26); the second processing means (downloading) processes the succeeding message (pcdma) by performing a procedure unique to the first system when the communication protocol in the first system is shown in the protocol revision message (col. 8 lines 6-50), and processes the following message by performing a procedure unique to the second system when the communication protocol in the second system is shown in the protocol revision message (col. 8 lines 6-50).

Allowable Subject Matter

3. Claims 6 and 7 are allowed.
4. The following is an examiner's statement of reasons for allowance: Regarding claim 6 the prior of record fails to teach or suggest, alone or in combination a "judging unit determines whether a format of the message corresponds to a program code which is common to each of the first and the second communication protocols, or whether the format of the message corresponds to a program code which is a judging unit coupled unique to one of the first and the second communication protocols; a first processing arrangement coupled to the reception unit, wherein the first processing arrangement has

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stored therein the program code which is common to each of the first and the second communication protocols, and the first processing arrangement processes the message when the format of the message corresponds to the program code which is common to each of the first and the second communication protocols, and a second processing arrangement coupled to the reception unit, wherein the second processing arrangement has stored therein the program code which is unique to the first communication protocol and the program code which is unique to the second communication protocol, wherein the second processing arrangement processes the message when the format of the message corresponds to the program code which is unique to one of the first and the second communication protocols".

Regarding claim 7, the prior of record fails to teach or suggest, alone or in combination a "judging unit determines whether a format of the message corresponds to a program code which is common to each of the first and the second communication protocols, or whether the format of the message corresponds to a program code which is unique to one of the first and the second communication protocols; a first processing arrangement coupled to the reception unit, wherein the first processing arrangement has stored therein the program code which

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is common to each of the first and the second communication protocols, and the first processing arrangement processes the message when the format of the message corresponds to the program code which is common to each of the first and the second communication protocols', and a second processing arrangement coupled to the reception unit, wherein the second processing arrangement has stored therein the program code which is unique to the first communication protocol and the program code which is unique to the second communication protocol, wherein the second processing arrangement processes the message when the format of the message corresponds to the program code which is unique to one of the first and the second communication protocols".

Response to Arguments

5. Applicant's arguments filed July 27, 2004 have been fully considered but they are not deemed to be persuasive. The following are explanations to the applicant arguments:

6. Argument: Applicant alleges that Ishii and Shamato do not disclose judging means for judging whether a received message has a common format in the two systems or a different format in the two systems and processing means for processing the received message by performing a procedure common to the two systems when the message has a common format; and a second processing means for processing the received message by performing procedures unique to each of the two systems, when the message have a different format. Applicant further discloses in new claims 6 and 7 in Applicant remarks on page 3 line 9 through page 4 line

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2), For example, as set forth in each of Applicant's independent the first processing means may have stored therein the program code which common to both portable telephone systems, e.g., the program code that is common to or shared by the protocols associated with each of the portable telephone systems. Similarly, as set forth in each of Applicant's independent claims 6 and 7, the second processing means may have stored therein the program code that is unique to the first portable telephone system and the program code that is unique to the second portable telephone system. As such, in Applicant's claimed invention, the second processing means may store program code that is unique to a first protocol used by the first portable telephone system, and program code that is unique to a second protocol used by the second portable telephone system. Moreover, the first processing means may store program code that is common to or is shared by both the first protocol and the second protocol, e.g., to reduce the amount of storage space required to store both the program code associated with the first system and the program code associated with the second system. Applicant submits that neither Ishii nor Shamoto discloses or suggests judging whether the format of the received message is common to the two systems.

Explanation: Examiner agrees with applicant that Ishii and Shamoto do not disclose the first processing means may have stored therein the program code which common to both portable telephone systems, the second processing means may have stored therein the program code that is unique to the first portable telephone system and the program code that is unique to the second portable telephone system. However, this limitation is not recited in claim 1. Examiner agrees with applicant on page 5 lines 15-19) that when the program code which currently is stored within the mobile radio telephone does not coincide with the program code used by the current mobile radio telephone system, the mobile radio telephone has to download the appropriate program code and replace the original program code with the downloaded program code. Again, claim 1 does not disclose the portable telephone stores the program codes used in both systems so when the portable telephone roams it could use the codes stored in its memory for connecting with a different system. Claim 1 recites a received message is common to both the first mobile radio system and the second mobile radio telephone system, however it does not disclose the first processing means may have stored therein the program code which common to both portable telephone systems, the second processing

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means may have stored therein the program code that is unique to the first portable telephone system and the program code that is unique to the second portable telephone system.

7. Argument: Applicant alleges that Shamato do not judge whether the format of the received signal is common to both the PDC system communication protocol and the PHS system communication protocol.

Explanation: Examiner respectfully disagrees with applicant because Shamato teaches a PDC/PHS phone (fig. 2) comprising a first processing means (PDC Base band processor) (fig. 2 number 5 and col. 3 lines 18-58) and a second processing means (PHS base band processor) (fig. 2 number 8 and col. 3 lines 18-58), the second processing means for processing the received message by performing procedures (i.e. the PDC/PHS phone processes the reception signal) (col. 3 lines 49-58), each procedure unique (i.e. the PDC/PHS phone "judging means") to each of the two systems (i.e. the PDC/PHS phone process the reception signal received either through the PDC communication network (fig. 1 number 20) or the PHS communication network (fig. 1 number 22 and col. 3 lines 49-58), when the message has the different format (different protocol, i.e. a PDC system communication protocol) (col. 3 lines 50-58).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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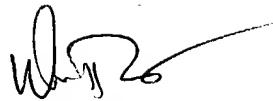
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Keith Ferguson

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November 9, 2004



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